

REMARKS

Applicant hereby respectfully submits this request for continued examination in which claims 15, 24, 25 and 26 have been amended. The antecedent basis for the amendment to claims 5 15, 24, 25 and 26 may be found on page 10, line 21 through page 12, line 5 of the specification. Specifically, the claims have been amended to more precisely reflect that the magnetic material on the auxiliary lens is capable of fitting solely below and mating with the magnetic material on the primary 10 frame. No new matter has been added.

With respect to the Office Action dated October 29, 2004, Applicant herein presents arguments to traverse the Examiner's §102(e), §103(a) and double patenting rejections. Similar arguments were raised in Applicant's Amendment and Response 15 dated December 29, 2004, which the Examiner did not enter.

Furthermore, in response to the Advisory Action dated January 7, 2005, Applicant presents arguments to traverse the Examiner's new matter objections.

20 I. RESPONSE TO EXAMINER'S REJECTIONS IN OFFICE ACTION DATED OCTOBER 29, 2004

A. Response to §102(e) Rejection Based Upon Chao

The Examiner has rejected claim 15 under 35 U.S.C. §102(e) 25 as being anticipated by Chao (U.S. Pat. No. 6,012,811). The Examiner did not reject independent claims 27 and 28 under Chao,

and Applicant assumes that these claims are allowable in view of Chao. As to claim 15, the Examiner has stated that

5 "[t]he limitations in claim 15 are shown in Chao et al's Fig. 16, column 8, lines 7-21. Chao et al discloses an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses comprising: magnetic material 358 on said auxiliary eyeglasses; said magnetic material 358 capable of fitting below and mating with magnetic material on said conventional eyeglasses, whereby said auxiliary eyeglasses are capable of being removably secured to conventional eyeglasses."

15 35 U.S.C. § 102 states that "[a] person shall be entitled to a patent unless - (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent. . . ." In applying § 102, MPEP § 706.02(a) instructs, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP §706.02(a) (page 700-21). The applicant respectfully traverses the § 102(e) rejection based upon Chao because the reference does not teach every aspect of applicant's claimed invention as amended.

25 Specifically, Chao does not teach an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses where the magnetic material on the auxiliary eyeglasses is capable of fitting solely below and mating with magnetic material on the

conventional eyeglasses. Accordingly, as this feature of amended claim 15 is not taught by Chao, Applicant respectfully traverses the 102(e) rejection.

5 A critical aspect of Applicant's invention, as amended, is that the magnetic material on the auxiliary glasses is capable of fitting solely below the magnetic material on the conventional glasses. In other words, the magnetic material of the auxiliary glasses is not required to also be attached from above to the magnetic material of the conventional glasses for 10 the glasses to hold together. This is clearly shown in Figures 1 and 3, illustrating the preferred embodiment. Such a disclosure is not present in Chao.

The Chao patent specifically teaches,

15 Fig. 16 shows the bridges of another embodiment of the present invention where the bridge of the auxiliary frame includes a U-shaped structure 350 having two arms, 352 and 354, one on top and one on the bottom of the bridge 360 of the primary frame. In one 20 embodiment, the magnetic member at the auxiliary frame includes two separate parts, with each part located at each arm of the U-shaped structure; for example, the member 358 at the arm 354, and the member 356 at the arm 352. Note that the members 356 and 358, each can 25 further include more than one portion, as in the second embodiment. In another embodiment, the bottom arm 354 does not include any magnetic member. In yet another embodiment, the bridge 360 of the primary frame also includes its magnetic member, disposed at a 30 location with the correct polarity with respect to the magnetic member of the auxiliary frame.

Chao patent, Col. 8, lines 7-21 (emphasis added).

It can be clearly seen that the *Chao* patent only teaches an apparatus for attaching auxiliary glasses to conventional glasses where the auxiliary glasses have a U-shaped bridge always having a magnet on the top arm. Thus, in *Chao*, all of the embodiments described in relation to Fig. 16 require that the magnetic material of the auxiliary glasses always attach to the conventional glasses from above, sometimes from above and below, and never only from below.

In addition, *Chao* does not disclose or describe a need for the magnetic material of the auxiliary glasses to attach only below the magnetic material of the conventional glasses. Even in *Chao's* embodiment that where the magnetic material of the auxiliary glasses fits below the conventional glasses (in addition to the magnet fitting above), the specification states, "[t]ypically, due to gravity, the magnetic member 356 at the top arm 352 of the auxiliary frame is magnetically coupled to the bridge of the primary frame, with a gap between the bottom arm and the bridge of the primary frame." Col. 8, lines 25-29.

This disclosure clearly teaches away from Applicant's invention because the magnetic material of the auxiliary glasses that fits below the conventional glasses does not even seem to be necessary, as it does not mate with any magnetic material, but instead simply hangs in the air. In fact, the magnetic material of the auxiliary glasses that fits below (358) is taken

out from the other described embodiment altogether, proving that it is not necessary to hold the conventional and the auxiliary glasses together.

Applicant, on the other hand, does not use a magnet on the auxiliary glasses that attaches to the magnetic material on the conventional glasses from above. Instead, Applicant accomplishes the goal of the invention via attaching the magnetic material of the auxiliary glasses solely below the magnetic material of the conventional glasses.

This is far removed from that which Chao teaches because Chao's attachment of the conventional and auxiliary glasses always requires the magnetic material of the auxiliary frame to be above the magnetic material of the conventional glasses. Applicant's invention is a considerable improvement over the prior art, including Chao, in that the magnetic material on auxiliary glasses can attach to the conventional glasses solely from below, and still hold the two glasses together.

Accordingly, since Chao does not disclose all elements of Applicants invention, as claimed in the amended claims, Examiner's 102(e) rejection is not applicable.

**B. Response To § 103(a) Rejection Based On Chao**

The Examiner rejected Claim 26 under U.S.C. § 103(a) as being unpatentable over Chao. The Examiner stated that although

claim 26 is a method claim, the method steps consist of the broad steps of "providing" and "mating" and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

5 35 U.S.C. § 103(a) states

10 "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that *the subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." (Emphasis added.)

15 In applying § 102(b), MPEP § 706.02(a) instructs, "[i]n a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made." MPEP §706.02(a) (page 700-21).

25 The Examiner has rejected claims 26, a method claim, on obviousness grounds in view of *Chao*. However, the Examiner has not rejected independent Claim 15, an apparatus claim, encompassing the main elements of the invention on obviousness grounds here, just on anticipation grounds. In other words, the obviousness type rejection made by the Examiner is predicated on the Examiner's anticipation rejection pursuant to *Chao*. Since this anticipation rejection was traversed above, it is

Applicant's position that the obviousness type rejection of claim 26 no longer applies.

As mentioned above, *Chao* specifically teaches fitting a magnetic material on the auxiliary glasses above and mating with the magnetic material on the conventional glasses. Applicant, on the other hand, does not fit the magnets of the auxiliary glasses above the magnets of the conventional glasses, but accomplishes the attachment via fitting the magnetic material of the auxiliary glasses solely below the magnetic material of the conventional glasses.

In a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims, and the modifications must be obvious to one of ordinary skill in the applicable art. As explained above, *Chao* does not contain any teaching that would make the modifications obvious and, in fact, *Chao* teaches away from the present invention, rather than suggests its value.

Consequently, *Chao* does not teach or suggest all of the elements claimed by the Applicant in claim 26. Accordingly, the 103(a) rejection of claim 26 is not proper.

**C. Response To § 103(a) Rejection Based On *Zider***

The Examiner rejected Claims 15-17 and 24-26 under U.S.C. § 103(a) as being unpatentable over *Zider*. The Examiner did not

reject independent claims 27 and 28 under *Zider*, and Applicant assumes that these claims are allowable in view of *Zider*.

As a basis for the rejection, the Examiner has stated,

5 [i]t would have been obvious to a person having  
ordinary skill in this art to modify the device in the  
Zider reference to form an apparatus for attaching  
auxiliary eyeglasses to conventional eyeglasses  
10 comprising magnetic material on said auxiliary  
eyeglasses; said magnetic material capable of fitting  
below and mating with magnetic material on said  
conventional eyeglasses, whereby said auxiliary  
eyeglasses are capable of being removably secured to  
15 conventional eyeglasses as suggested by Zider for the  
same purposes as the applicant does. Regarding claim  
26, it should be noted that although claim 26 is a  
"method claim", the method steps consist of the broad  
steps of "providing" and "mating" and therefore these  
20 steps would be inherently satisfied by the apparatus  
of the reference as modified.

The Examiner's rejection of claims 15-17 and 24-26 pursuant  
to 35 U.S.C. § 103(a) as being unpatentable over *Zider* is  
respectfully traversed. The Applicant believes that this  
25 invention as presently claimed falls outside of the subject  
matter indicated, taught, or suggested by *Zider*. According to  
MPEP § 706.02(j):

30 "[t]o establish a prima facie case of  
obviousness, three basic criteria must be met. First,  
there must be some suggestion or motivation, either in  
the references themselves or in the knowledge  
generally available to one of ordinary skill in the  
art, to modify the reference or to combine reference  
35 teachings. Second, there must be a reasonable  
expectation of success. Finally, the prior art  
reference (or references when combined) must teach or  
suggest all the claim limitations."



First, Zider does not teach or suggest all the claim limitations of claims 15-17 and 24-26 as amended. Specifically, Zider does not teach or suggest an apparatus for attaching auxiliary eyeglasses to conventional eyeglasses where the magnetic material on the auxiliary eyeglasses is capable of fitting solely below and mating with magnetic material on the conventional eyeglasses.

A critical aspect of Applicant's invention is the orientation of magnets, which is shown more clearly in Fig. 3. See Specification, page 11, lines 4-6. According to the Applicant's invention, as amended, the magnetic material on the auxiliary glasses is capable of fitting solely below the magnetic material on the conventional glasses. The magnets are oriented in such a way as to have an axis that is vertically oriented and is approximately parallel to auxiliary frame and conventional eyeglass frame. See Specification, page 11, lines 7-10. Such a disclosure is not present in Zider.

Zider, as easily seen in its Abstract, teaches an apparatus for attaching auxiliary glasses to conventional glasses where the mounting arrangement includes a male part having a projection thereon and a female part having a recess therein. Thus, in Zider, all of the embodiments described require that the magnetic material of the auxiliary glasses always attach to

the conventional glasses from both above and below, and never only from below.

By definition, a male part has to go into the female part, not be above it or below it. In other words, once a magnetic projection of the auxiliary lenses described in Zider goes into the magnetic recess of the conventional lenses, the projection is in between, i.e., both above and below the sidewalls of the recess. Contrary to Zider, Applicant's claims, as amended, include an element requiring that the magnetic material of the auxiliary lenses be capable of fitting only below the magnetic material of the conventional lenses and still achieving the object of the invention in holding the glasses together. Thus, Zider does not teach all of the claim elements of claims 15-17 and 24-26.

Second, Zider provides no suggestion or motivation in itself or in combination with knowledge generally available to one of ordinary skill in the art, to modify Zider in order to meet all claim limitations of the Applicant's invention. Furthermore, there is no teaching or suggestion in Zider that would provide a reasonable expectation of success to one of ordinary skill in the art set out to modify Zider in order to construct an apparatus that meets all of Applicant's claim limitations. Specifically, Zider does not disclose or describe a need for the magnetic material of the auxiliary glasses to

attach only below the magnetic material of the conventional glasses.

In fact, *Zider* describes one of the main advantages of his invention being that the projection of the male part is fitted within and engages the recess of the female part, improving the holding power of the auxiliary eyeglasses onto the primary frame and preventing lateral movement of the auxiliary glasses with respect to the primary frame. See *Zider*, Col. 1, lines 62-65, Col. 2, lines 14-18 and 27-30.

This disclosure clearly teaches away from Applicant's invention because the whole purpose of the invention described in *Zider* is achieved by orienting one magnetic material (male) inside of a magnetic recess (female). In other words, *Zider* requires the magnetic material of the auxiliary glasses to be not above or below, but above and below the magnetic material of the primary glasses.

For all of the above reasons, in view of the amendments and remarks herein, the *Zider* reference does not make out a prima facie case of obviousness as to claims 15-17 and 24-26. Accordingly, the 103(a) rejection is not proper.

**D. Response To the Double Patenting Rejections**

The Examiner has rejected claims 15-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,550,913. To

overcome this rejection, Applicant has filed a terminal disclaimer in compliance with 37 CFR 1.321 (c), which is attached to this response. Thus, the double patenting rejection of claims 15-28 with respect to U.S. Patent No. 6,550,913 should  
5 be withdrawn.

The Examiner has also rejected claims 15-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,139,142. To overcome this rejection, Applicant has filed a terminal  
10 disclaimer in compliance with 37 CFR 1.321 (c), which is attached to this response. Thus, the double patenting rejection of claims 15-28 with respect to U.S. Patent No. 6,139,142 should be withdrawn.

Applicant also acknowledges that the Examiner withdrew the  
15 previously-made double patenting rejection of claims 15-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,705,722, after Applicant filed a terminal disclaimer in the previous response. Thus, all of the double patenting  
20 rejections made by the Examiner have been addressed and overcome by the Applicant through the use of timely filed terminal disclaimers.

II. RESPONSE TO EXAMINER'S NEW MATTER OBJECTIONS AS STATED IN HIS ADVISORY ACTION DATED 01/07/05

The Examiner objected to and did not enter Applicant's  
5 Amendments and arguments raised in Applicant's Amendment and  
Response dated December 29, 2004 because he believes that they  
raise new issues and new matter. Specifically, the Examiner has  
stated, "The proposed amendment creates new issues and/ or new  
matter because the 1<sup>st</sup> magnet is not only capable of fitting  
10 below, but also capable of fitting above and mating with the 2<sup>nd</sup>  
magnet. See Figs 1-4." See NOTE, Continuation of 2.

New matter is defined as matter that is not disclosed in  
the original specification, claims or drawings. See MPEP  
608.04(a). Applicant respectfully traverses the Examiner's new  
15 matter objection because Applicant's aforementioned amendment  
and arguments do not contain new matter or create new issues.  
Figures 1 through 4 indeed disclose and support Applicant's  
claims in which the magnetic material on the auxiliary  
eyeglasses is capable of fitting solely below and mate with the  
20 magnetic material on the conventional eyeglasses.

FIGS. 1 through 4 illustrate the invention in which the  
auxiliary eyeglass frame 16 is attached to the conventional  
eyeglass frame 20 by magnets 26 embedded in an appendage 18  
mating with similar magnets 30 embedded in a temple extension  
25 24. FIG. 3 specifically illustrates the point of connection or  
attachment of the auxiliary eyeglass frame 16 to the

conventional eyeglass frame 20. As shown in FIG. 3, when magnet 26 of auxiliary frame 16 mates with magnet 30 of conventional eyeglass frame 20 at a point below magnet 30, auxiliary lens 14 precisely lines up with conventional lens 21 and thereby, perfectly fits on to conventional lens 21. Magnet 26 is not capable of fitting above and mating with magnet 30 because then auxiliary lens 14 would not structurally line up with conventional lens 21, which would render Applicant's invention inoperable.

Based on the foregoing, Applicant respectfully requests the Examiner to withdraw its new matter objection as contained in the Advisory Action and thereby enter and consider Applicant's aforementioned amendments and arguments in support of patentability.

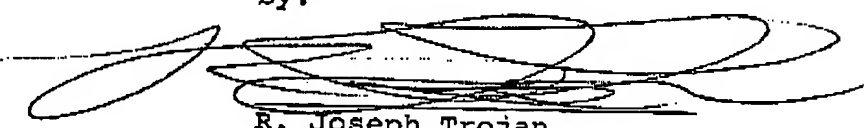
Conclusion

In light of the above arguments, Applicant respectfully requests the Examiner to withdraw its new matter objection as  
5 contained in the Advisory Action and thereby enter and consider Applicant's aforementioned amendments and arguments in support of patentability. Applicant has submitted the \$395.00 fee for the Request for Continued Examination in accordance to 37 CFR 1.17(e). If any additional fees are required, the Director is  
10 authorized to deduct the required amounts from Deposit Account No. 500703.

15 Respectfully submitted,

Trojan Law Offices  
By:

20 Date: January 26, 2005



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